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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,454	10/15/2001	Mark D. Erion	030727.0027.CON1	5123

23865 7590 10/24/2002
BROBECK, PHLEGER & HARRISON LLP
12390 EL CAMINO REAL
SAN DIEGO, CA 92130

EXAMINER

JONES, DAMERON LEVEST

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 10/24/2002 ✓

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

OCT 28 2002

Brobeck, Phleger & Harrison LLP

DOCKETED

OCT 29 2002

Brobeck c

Office Action Summary	Application No. 09/978,454	Applicant(s) ERION ET AL.	
	Examiner D. L. Jones	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/15/01; 1/22/02; 1/25/02; and 3/27/02.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 168-185 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

PREVIOUS OFFICE ACTION VACATED

1. The office action mailed 8/29/02, Paper No. 5, is VACATED in view of the following action.

ACKNOWLEDGMENTS

2. The Examiner acknowledges receipt of the following:
 - a. Paper No. 2, filed 10/15/01, wherein claims 2-167 were canceled;
 - b. Paper No. 3, filed 1/22/02, wherein claim 1 was canceled and claims 2-12 were added. (Claims 2-12 were renumbered as claims 168 – 178 according to 37 CFR 1.126);
 - c. Paper No. 3 ½, filed 1/25/02, wherein claims 5 (previously renumbered as claim 171 under 37 CFR 1.126) was amended and claim 13 was added (Claim 13 was renumbered as claims 179 according to 37 CFR 1.126); and
 - d. Paper No. 4 ½, filed 3/27/02, wherein claims 14 – 19 were added (Claims 14 – 19 were renumbered as claims 180 - 185 according to 37 CFR 1.126).

Note: Claims 168 – 185 are pending.

ELECTION OF SPECIES

3. Claims 168 – 185 are generic to a plurality of disclosed patentably distinct species comprising phosphorous-containing compounds. In particular, the compounds may have the structures as set forth in independent claims 168, 180, 181, 182, 183,

Art Unit: 1616

184, and 185. Applicant is required under 35 U.S.C. 121 to **elect a single disclosed species**, even though this requirement is traversed.

Note: *The Examiner respectfully requests that the Applicant elect a single species for search purposes and assign each variable the appropriate value for the elected species (i.e., X = hydrogen; Z = nitrogen; Y = -CH₃; etc.). In addition, Applicant is respectfully requested to state which claims are drawn to the elected species.*

4. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Due to the complexity of the restriction requirement, a telephone call regarding an oral election to the above restriction requirement was not made.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1616

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


COMMENTS/NOTES

8. It is duly noted that Applicant has canceled all the method claims and added all compound/composition claims.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (703) 308-4640. The examiner can normally be reached on Mon.-Fri. (alternate Mon.), 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose' Dees can be reached on (703) 308- 4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


D. L. Jones
Primary Examiner
Art Unit 1616

October 21, 2002